<u>REMARKS</u>

Applicant has reviewed the Application in light of the Final Office Action dated September 19, 2008 ("Office Action") and the Advisory Action dated December 26, 2008 ("Advisory Action"). Claims 2, 9, and 12 were previously cancelled. Claims 1, 4, 8, 10, and 11 are amended as set forth above. Thus, Claims 1, 3-8, 10-11, and 13-17 remain pending in the application. Applicant submits that no new matter has been added with the amendments. Applicant respectfully requests reconsideration of the application in accordance with the following remarks.

<u>Section 112 Rejections</u>

Claims 1, 10, and 11 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Further, Claims 1, 10, and 11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action rejected Claims 1, 10, and 11 on the grounds that the phrase "the text content in an unambiguous reading order" fails to meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Applicant respectfully disagrees with the Office Action's characterization that Claims 1, 10, and 11 fail to satisfy the requirements of 35 U.S.C. § 112, first and second paragraphs. However, to further prosecution, Applicant has amended the claims to recite "converting the text content into a canonical form, wherein the text content is in an unambiguous reading order," as previously recommended in the Office Action at p. 3, ¶ 3. Applicant submits that such amendments are for clarification purposes only and do not affect the scope of the claims. Accordingly, Applicant respectfully requests withdrawal of the § 112 rejections.

<u>The claims are allowable over the cited art</u>

Claims 1, 3–8, 10, 11, and 13–17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0069179 to Slater *et al.* ("*Slater*") in view of U.S. Patent No. 6,634,559 to Shioda ("*Shioda*"). Applicant respectfully traverses the rejection and assertions and holdings therein, because the above cited art, whether

individually or in combination, fails to teach, suggest, or disclose certain aspects of the present claims including, for example, amended Claim 1.

Put simply, *Slater* fails to teach printing an electronic document for use with an external entity that does not exchange electronic documents with a workflow system, while *Shioda*, merely teaches including a reduced image, or preview, of its document on the data sheet along with an additional image of computer-encoded characters. Thus, these references do not teach, whether alone or in combination, that a print out of the electronic document is created that includes a full-sized version of the human-readable document appearance representing the electronic document's text content prior to sending the print out to the external entity, thus allowing for full and easy review of the electronic document by a person associated with the external entity without requiring decoding of the document's content.

For example, the *Slater-Shioda* combination at least fails to teach or suggest creating a print out "including a full-sized version of the human-readable document appearance representing the text content [of the associated electronic document]" and a "barcode representation of [ ] one or more first control codes and [ ] one or more second control codes," where the one or more first control codes each correspond to a respective approval code and the one or more second control codes are generated from the canonical form of the text content, and then, after creating the print out, "sending the print out to [an] external entity" as recited by Claim 1. First, the Office Action acknowledges that *Slater* fails to explicitly teach generating an electronic document in a workflow system for use with an external entity that does not exchange electronic documents with the workflow system. The Office Action alleges that *Shioda* corrects *Slater's* deficiencies:

> "...a data sheet that can be carried by the user (abstract.) The data sheet includes a printout of the encoded entire electronic document on paper (col. 2, lines 22-63). The data sheet, which includes the entire document on a printout (not stored electronically), is distributed to other systems by the user."

Office Action, p. 6, ¶ 9.1. Applicants traverse this allegation.

Applicant submits that *Shioda* does not teach where a print out of the electronic document includes <u>a full-sized version of the human-readable document appearance representing the text content</u> of the electronic document, and further fails to teach that the print out with the

full-sized version of the human-readable document appearance is created prior to sending the print out to the external entity as recited by Claim 1. At best, *Shioda* teaches that a small area of the data sheet can "stor[e] a reduced image of at least a part of the document for a user to preview the document" so that a portion of the data is in human-readable format, and so that a "user can recognize contents of a document recorded on the data sheet." *Shioda*, 3:5-17; 6:38-40.[1] But *Shioda* also teaches that the data representing the complete document is encoded on the data sheet and is only understandable (or made into a full-sized version of the human-readable document appearance) after the encoded portion of the data sheet is decoded by a data reading unit. *See id.* In discussing the teachings of *Shioda*, the Office Action specifically acknowledges that "a decoding unit decodes the <u>encoded entire document</u> [from the data sheet] to obtain the <u>entire document back</u>" in a human-readable form. Office Action, p. 6, ¶ 9.1 (emphasis added). Further, *Shioda* teaches that the entirety of the electronic document is only decoded, and thus a full-sized version of the human-readable document appearance is only available, after the data sheet reaches its final destination and is decoded by the appropriate decoding unit. In other words, the data representing the full-size version of the human-readable electronic document associated with the data sheet is permanently presented in a form that is not recognizable by a human, in direct contrast to the argument of the Advisory Action. *Contra* Advisory Action p. 2, ¶ 2. In fact, the Advisory Action acknowledges that *Shioda* "teaches an embodiment that makes the data unrecognizable by unauthorized users" (*e.g.*, users without a decoding unit) in the data sheet. *Id.* In contrast, the created print out recited by Claim 1 includes "a full-sized version of the human-readable document appearance representing the text content," whereas *Shioda* (at best) teaches a thumbnail or other preview of the information contained within the encoded section of the data sheet. Thus, *Shioda* also fails to teach or suggest that a print out which includes the full-sized version of the human-readable document appearance of the electronic document is created <u>prior to</u> "sending the print out to the external entity" as recited in Claim 1,

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[1] *Shioda* teaches that a printed data sheet can be used to manually distribute electronic documents between users within an office environment. *See Shioda*, 2:40-47. The data sheet comprises two portions, an upper portion of the data sheet providing the reduced images of at least a part of the document and a lower portion of the data sheet comprising an encoded (or non-human-readable) version of the electronic document text and data. *See, e.g., id.* at 5:35-46, 6:18-23, FIGS. 1-3.

which allows the print out to contain the full-sized version of the human-readable document appearance when the print out is sent to the external entity outside of the workflow.

Further, the *Slater-Shioda* combination fails to teach or suggest generating "one or more first control codes that each correspond to a respective approval code, wherein the one or more first control codes authenticate the respective approval code, and one or more second control codes generated from the canonical form of the text content, wherein the one or more second control codes authenticate the text content," and "creating a print out of the electronic document…including a barcode representation for the one or more first control codes and the one more second control codes" as recited in Claim 1. In the Office Action and Advisory Action, the control codes of Claim 1 have been compared to the encrypted digital signatures in *Slater*. However, *Slater* does not teach or disclose printing control codes represented as barcodes. *Shioda*, on the other hand, does disclose including a barcode on its data sheet. *See Shioda*, 6:57-7:11.[2] In fact, *Shioda* explicitly states that its "control code" can be presented as a barcode. *Id*. at 13:66-14:14.[3] However, the "control codes" taught by *Shioda* are not equivalent to the first and second control codes disclosed in Claim 1. For example, the control codes of *Shioda* are used "to perform processes planned by a creator of the printed matter." *Id*. at 6:57-7:11. Conversely, Claim 1, for example, recites that the one or more first control codes each correspond to and authenticate a respective approval code and that the one or more second

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[2] "The bar code 115 includes codes used by a reading device to perform processes planned by a creator of the printed matter. In details, the bar code 115 includes codes used by the reading device for confirming a password for the printed matter, permitting the printed matter only to be printed, enabling only creation of a file or only fax of the file, or letting a holder of the printed matter select a process among several processes by displaying a menu. It should be noted that the bar code 115 may include information about the password. Additionally, contents of the processes recorded in the bar code 115 can be included in the beginning or the end part of the coding part 113, for instance. Similarly, in the case of confirming the password, the information about the password may be included in the beginning or the end part of the coding part 113, for example. Additionally, a two-dimensional bar code may be applied to the bar code 115." *Shioda*, 6:57-7:11.

[3] "At the step S21, the computer 1 displays a screen asking the user whether to use a control code or not. The control code is the bar code 115 and the like, and may be included in the beginning or the end area of the coding part 113. If the user inputs a response to use the control code at the step S21, the computer 1 displays a screen used by the user for specifying contents of a process indicated by the control code, at a step S22. The contents of the process includes, for instance, a process to print all the pages of the document, a process to print a part of the document, a process to store or to transmit and store the file, a process to allow the user to select one of the above-described processes, and a process to inspect a password. Such contents of the processes are stored in the memory or the like. On the other hand, if the user inputs a response not to use the control code at the step S21, the computer 1 proceeds to a step S23." *Shioda*, 13:66-14:14.

control codes are generated from the canonical form of the text content in order to authenticate that text content. Still further, Claim 1 recites that the first and second control codes are represented as barcodes when the print out is created, which are usable to authenticate the one or more approval marks and to validate the text content of the print out. In *Shioda*, the bar codes representing the control codes are not disclosed as corresponding to and authenticating an approval code, nor are the bar codes of *Shioda* taught to authenticate the text content of the electronic document as recited in Claim 1.

Accordingly, the *Slater-Shioda* combination fails to teach, suggest, or disclose each and every element recited in example Claim 1. For at least these reasons, Applicant respectfully requests withdrawal of the § 103 rejections, as well as reconsideration and allowance of Claim 1 and its dependents. Further, independent Claims 8, 10, and 11 recite certain elements analogous to those of Claim 1. For at least reasons similar to those discussed with regard to Claim 1, independent Claims 8, 10, and 11, as well as their dependents, are also allowable over the *Slater-Shioda* combination. Thus, Applicant respectfully requests that the rejections of those claims also be withdrawn and the claims be allowed.

<u>CONCLUSION</u>

Applicant has made an earnest attempt to place this case in condition for allowance. It is believed that all of the pending claims have been addressed. Applicant notes that the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all Claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

A Request for Continued Examination, Petition for One-Month Extension of Time, and Information Disclosure Statement, as well as any fees required for filing same are being filed and submitted concurrently with this Amendment In Reply to Final Action of September 19, 2008 and Advisory Action dated December 26, 2008. Please apply any other required fees or credits to PTO Deposit Account No. 06-1050, referencing the above attorney docket number.

Respectfully submitted,

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/Thomas H. Reger II/

Thomas H. Reger II
Reg. No. 47,892

PTO Customer No. 32864
Fish & Richardson P.C.
1717 Main Street, Suite 5000
Dallas, Texas 75201
Telephone: (214) 292-4084
Facsimile: (877) 769-7945